Attorney Docket No.: DE030369

REMARKS

I. INTRODUCTION

Claim 20 has been cancelled. Claims 9, 11-13, and 15-17 have been amended. No new matter has been added. Thus, claims 1-4, 6-19 remain pending in the present application. Applicants thank the Examiner for the allowance of claim 10. However, in view of the above amendments and the following remarks, it is respectfully submitted that all of the pending claims are allowable.

II. THE CLAIM OBJECTIONS SHOULD BE WITHDRAWN

The Examiner objected to claims 12-17 for depending on a cancelled claim. (See 6/2/08 Office Action, p. 2). Based on the amendments to claims 12-13 and 15-17 to correct their dependency, Applicants respectfully request that the objections to claims 12-17 be withdrawn.

III. CLAIM REJECTIONS – 35 U.S.C. § 101

Claims 1-4, 6-9 and 11-19 stand rejected under 35 U.S.C. § 101 as overlapping two different statutory classes of inventions, namely a "machine" and "process." (See 6/2/08 Office Action, p. 2). Applicants respectfully submit that the Examiner has not provided a proper rejection under 35 U.S.C. § 101. There is no requirement that a claim must fall within a single or exclusive statutory category, merely that the claim falls within permitted statutory categories. In fact, the MPEP states:

> For example, a claimed invention may be a combination of devices that appear to be directed to a machine and one or more steps of the functions performed by the machine.

> Such instances of mixed attributes, although potentially confusing as to which category of patentable subject matter the claim belongs, does not affect the analysis to be performed by USPTO personnel. Note that an apparatus claim with process steps is not classified as a "hybrid" claim; instead, it is simply an apparatus claim including functional limitations. See, e.g., R.A.C.C. Indus. v. Stun-Tech, Inc., 178 F.3d 1309 (Fed. Cir. 1998) (unpublished).
>
> MPEP 2106 IV.B.

Thus, the MPEP specifically contemplates the types of claims that are presented in the present application. The Examiner has not indicated that any of the subject matter of the claims falls outside the defined statutory categories. Accordingly, the 35 U.S.C. § 101 rejection should be withdrawn.

IV. THE 35 U.S.C. § 112 CLAIM OBJECTIONS SHOULD BE WITHDRAWN

Claims 1-4, 6-9 and 11-19 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for claiming both apparatus and method steps. (See 6/2/08 Office Action, p. 3). As stated above, claiming an apparatus with functional limitations is fully permissible. Accordingly, the 35 U.S.C. § 112, second paragraph, rejections should be withdrawn.

V. CLAIM REJECTIONS – 35 U.S.C. § 102(b)

Claims 1-4, 6-9 and 11-19 stand rejected under 35 U.S.C. § 102(b) as anticipated U.S. Patent No. 6,377,656 to Ueki et al. (hereinafter "Ueki"). (See 6/2/08 Office Action, p. 3).

Ueki describes an X-ray apparatus for controlling the output power of an X-ray tube by utilizing a mean value of a weighted histogram. (See Ueki, abstract). The histogram is obtained by multiplying a histogram of numbers of data corresponding to image intensities in a reference image which is an X-ray image picked up in an X-ray fluoroscopy mode and a weighting function whose variable depends on the image intensities. (See Id.).

Independent claim 1 recites "control of the X-ray apparatus on the basis of the calculated, adjusted imaging parameters, wherein the visibility criterion is the contrast-to-noise ratio of the image region of interest." In Ueki the X-ray device compares image intensities (pixel values) of a particular area with a predetermined value to determine the power of the X-ray tube. (See Ueki, col. 2, lines 32-45). Thus, Ueki does not suggest adjusting X-ray power based on the contrast-to-noise ratio.

Applicants also note that the Examiner indicated in the previous Office Action that Ueki fails to teach or make obvious "wherein the visibility criterion is the contrast-to-noise ratio of the image region of interest," as previously recited by cancelled claim 5. (See 11/28/07 Office Action, p. 4). The Examiner conceded that this cancelled claim would be allowable if rewritten to overcome a 35 U.S.C. § 112, second paragraph rejection. This rejection has been addressed above and cancelled claim 5 has been incorporated into claim 1. Accordingly, Ueki does not teach or suggest "wherein the visibility criterion is the contrast-to-noise ratio of the image region of interest," as recited by claim 1. Accordingly, this rejection should be withdrawn. Because claims 2-4, 6-8 and 11 depend from allowable claim 1, and therefore include all the limitations of claim 1, it is respectfully submitted that these claims are also allowable for at least the same reasons given above with respect to claim 1. Accordingly, these rejections should be withdrawn.

Independent claim 9 recites "wherein the visibility criterion is a contrast-to-noise ratio of the image region of interest." Thus, for the same reasons as described above with reference to claim 1, claim 9 is also allowable. Because claims 12-19 depend from allowable claim 9, and therefore include all the limitations of claim 9, it is respectfully submitted that these claims are also allowable for at least the same reasons given above with respect to claim 9. Accordingly, these rejections should be withdrawn.

Attorney Docket No.: DE030369

CONCLUSION

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Dated: September 2, 2008

By: _____
Michael Marcin (Reg. No. 48,198)

Fay Kaplun & Marcin, LLP
150 Broadway, Suite 702
New York, New York 10038
Tel.: (212) 619-6000
Fax: (212) 619-0276